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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,494	08/27/2001	Hans Leysieffer	740105-75	2879

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NIXON PEABODY, LLP  
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WASHINGTON, DC 20004-2128

EXAMINER

MACHUGA, JOSEPH S

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,494

Applicant(s)

LEYSIEFFER, HANS

Examiner

Joseph S. Machuga

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 23-28 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

Applicant's arguments have been given careful consideration but are not deemed persuasive. While applicants arguments are understood regarding the limitation "without the provision of a separate energy storage housing," the language in the claims to define this feature is not sufficient to define over the prior art of record. For example, The Kolenik #3926198 reference discloses a pacemaker. The energy storage unit is located in one of two chambers and all the components are in the same housing as clearly illustrated in Figure 2. In this reference the energy storage is disposed within the first chamber without the provision of a separate energy storage housing such as that found in the references to Spence #6530876 or Lewis et al #6146325. Accordingly, all the claimed features are provided for.

The amendment to paragraphs [0018] and [0022] should be checked. The information appears inaccurate.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 8, 9, 11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kolenik #3926198.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 10-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al #5279292 in view of Kolenik #3926198.

4. Baumann et al discloses a hearing aid implant. The device includes a housing 36 constructed of biocompatible material that by the description appears to be cylindrical. The housing includes two compartments. The first one houses a battery 25 and circuitry 30/38. The second compartment houses a charging coil 15. Not disclosed by this reference is the separation wall between the battery and the electronics and the cap. Kolenik discloses an implantable pacemaker. The reference teaches adding a hermitically sealed separation wall between the battery and the electronics to prevent damage to the electronic circuitry. The reference also teaches sealing the assembly by means of a cap and adding a secondary backup battery.

5. Given these teachings it would have been obvious to one of ordinary skill in the art to add a hermetically sealed separation wall between the battery and the electronics in Baumann et al's hearing aid given Kolenik's teaching that this is desirable to protect the circuitry. To seal the assembly by means of a cap would have been obvious given Kolenik's teaching that this provides a seal which is effective in an implant. Finally, to add a backup battery to provide protection against failure of the primary battery would have been obvious to one of ordinary skill in the art given Kolenik's teaching of this.

6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al #5279292 in view of Kolenik #3926198 and Engebretson et al #4988333.

7. Baumann et al discloses a hearing aid implant. The device includes a housing 36 constructed of biocompatible material that by the description appears to be cylindrical. The housing includes two compartments. The first one houses a battery 25 and circuitry 30/38. The second compartment houses a charging coil 15. Not disclosed by this reference is the separation wall between the battery and the electronics.

8. Kolenik discloses an implantable pacemaker. The reference teaches adding a hermitically sealed separation wall between the battery and the electronics to prevent damage to the electronic circuitry. The reference also teaches sealing the assembly by means of a cap and adding a secondary backup battery.

9. Engebretson et al discloses a hearing aid. The reference teaches that a cylindrical shape for the hearing aid implant is old and well known.

10. Given these teachings it would have been obvious to one of ordinary skill in the art to add a hermetically sealed separation wall between the battery and the electronics in Baumann et al's hearing aid given Kolenik's teaching that this is desirable to prevent gases from the battery from affecting the electronics. To make the housing 36 cylindrical would have been obvious given Engebretson et al's teaching that it is old and well known and would also conform to the charging coil (17.)

11. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al in view of Kolenik and Engebretson et al as applied to claims 3-5 above, and further in view of Berrang et al #US2002/0019669.

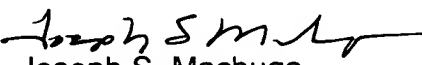
12. Berrang et al discloses a implantable hearing aid having a housing (2,3,6.) Attached and in mechanical contact with the housing is a charging coil (1) that is disposed in a biocompatible polymer. Also attached to the housing with feed through contacts is microphone (9.) The components are spread out to allow for flexibility during growth of the patient.

13. To position the coil outside the housing and a microphone to Baumann et al's device would have been obvious given Berrang et al's disclosure that this arrangement is old and well known in the art and adds flexibility to the system.

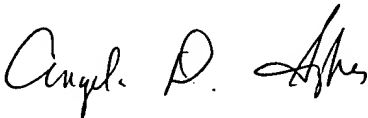
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Machuga whose telephone number is 703-305-6184. The examiner can normally be reached on Monday-Friday; 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joseph S. Machuga  
Examiner  
Art Unit 3762

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ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700